

**REMARKS**

Claims 1-4 are pending and under examination in this application. Applicant respectfully traverses the rejection of all claims under 35 U.S.C. § 103(a) as unpatentable over the patent to Yabuki et al. (U.S. 5,716,293). Reconsideration and withdrawal of the Final Rejection is respectfully solicited.

The difference between the golf ball according to the present application and the golf ball described and claimed in the cited Yabuki et al. reference resides in the specific composition of the intermediate layer which surrounds the inner core of the three piece golf ball. This intermediate layer is specified in the present application as a thermoplastic resin, which can be selected, from a polyurethane thermoplastic elastomer, a polyester thermoplastic elastomer, and a polyamide thermoplastic elastomer, as well as a mixture of such elastomers.

In the official action, the Examiner argues in the paragraph of Response to Arguments that "applicant claims a polyurethane thermoplastic elastomer, polyester thermoplastic elastomer, polyamide thermoplastic elastomer or a mixture thereof, all of which are categorized as thermoplastic resins." However, with respect, the Examiner's argument is incorrect. In the context of the present specification, these terms differ in meaning from "thermoplastic resin."

In the field of this invention, the thermoplastic elastomer is not categorized as a resin, but an elastomer. If the term "thermoplastic" only is selected, then the thermoplastic elastomer term is categorized in it. However, if the term "thermoplastic resin" is chosen, then the thermoplastic elastomer term is different from the thermoplastic resin term.

When we consult *Ullmann's Encyclopedia of Industrial Chemistry*, we do not find "thermoplastic resin", but find "thermoplastic elastomer" having about thirty pages, of which a copy is herewith enclosed as Appendix 1. We then search the term "plastic" in *Ullmann* and find the "thermoplastic elastomer" in the last item of "Heterogeneous Blends". This indicates that the thermoplastic elastomer is categorized in "plastic," but is very unique and specific. A copy of table of contents of plastic is herewith enclosed as Appendix 2. We also consult *Kirk-Othmer, Encyclopedia of Chemical Technology* and find that the thermoplastic elastomer is not contained in "Resin", but contained in "Elastomers, synthetic", of which a copy is enclosed as Appendix 3.

As is apparent from the above, the thermoplastic elastomer is generally not categorized in thermoplastic resin and is considered to be different therefrom.

If the persons skilled in art see the term "thermoplastic resin" and "ionomer resin" as its example, they hardly think that the thermoplastic elastomer is included in the term.

The cited Yabuki corresponds to a Japanese Publication No. 173504/1997. It was the invention described in this Japanese patent publication which the inventor of the present application studied and improved the intermediate layer covering the inner rubber core of the three-piece golf ball.

The Yabuki reference mentions only one specific thermoplastic resin, namely an ionomer resin. Other thermoplastic resins are described as well. In column 3, lines 38-47, examples of the thermoplastic resin are listed as "ionomer resin, acrylonitrile-butadiene rubber (NBR), chloroprene rubber (CR), urethane rubber, fluorosilicone rubber and the like". The listing of the thermoplastic resins omits mention of any of the specific thermoplastic resins, which the present application lists as the preferred thermoplastic elastomers and the main claim has been limited to those preferred thermoplastic elastomers. The common characteristic of all the thermoplastic resins is described at column 3, lines 32-37. The intermediate or coating layer for the inner core "may be any one which can prevent the bleeding of the oily substance contained in the inner spherical rubber. An oil-resistant substance having a flexibility is generally used and, specifically, a thermoplastic resin and an oil-resistant rubber are used as the main material".

The Examiner has stated that "the thermoplastic resins claimed by applicant are commonly known in the art and are suitable for the

purpose" of preventing the oily-substance from bleeding through the inner core to the outside. The Examiner has based his opinion of obviousness on the law as stated in a case decided by the Court of Customs and Patent Appeals in 1960 known as *In re Leshin* and it is reported at 125 U.S.P.Q. §416 - §419. The author of this decision is Judge Giles Rich who was the architect of the revision of The United States Patent Law, which defined the meaning of unobviousness. Judge Rich's decision is a model of clarity and thoroughness. After the decision is read, one wonders whether selecting a suitable resin can rise to the level of unobviousness. However, there are differences in the facts of the *In re Leshin* case and the present application.

While the principles of law remain unchanged, as long as the facts are different, it is possible to reach a different conclusion. In fact, if one reads the *Leshin* case carefully, one can see how a difference in the facts can result in a finding of unobviousness in the proper situation. Thus Judge Rich found that the subject of claim 18 in the *Leshin* case did indeed reach the level of invention where it could be found on the facts that as the claim reads a patentable or unobvious feature was defined. Thus claim 18 was found to be patentable over the art and the decision of the U.S. Patent Office Board of Appeals was reversed as to the patentability of claim 18. The only point which required clarification was that the fact that claim 18 was written as a dependent claim on a claim

which was found to be invalid. Therefore, Judge Rich found that it could be allowed only in independent form. Nevertheless, the point of the decision was favorable to a finding of unobviousness.

Applying what is learned from the cited decision *In re Leshin* to the present invention, it is believed that the selection of thermoplastic elastomers not only can prevent bleeding of an oily substance from the inner spherical rubber, but also result in a surprisingly more acceptable and improved golf ball than the golf ball of the cited reference. Thus, we argue to patentability based upon other more recent Federal Circuit Court decisions, which are favorable to the finding of unobviousness on the appropriate facts. Such decisions are *In re Dembiczak*, 50 U.S.P.Q. 2<sup>nd</sup> 1614 (Fed. Cir. 1999) and *In re Kotzab*, 55 U.S.P.Q. 2<sup>nd</sup> 1313 (Fed. Cir. 2000). These cases support the position that a reference may not be relied upon by the Examiner to reject a claim as obvious, unless the references contains a suggestion or motivation to select specific thermoplastic elastomers as in the present claims limited to contain specific elastomers which are unexpectedly superior in the resulting golf ball's performance.

The Examiner is respectfully requested to enter this Reply After Final in that it raises no new issues. Alternatively, the Examiner is respectfully requested to enter this Reply After Final in that it places the application in better form for Appeal.

Pursuant to 37 C.F.R. § 1.17 and 1.136(a), Applicants respectfully petition a two (2) month extension of time for filing a response in connection with the present application. The required fee of \$400.00 is attached hereto.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment: Appendices 1-3

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